

### **REMARKS/ARGUMENTS**

Reconsideration of this application is respectfully requested in view of the foregoing amendments and discussion presented herein.

1. Objection to Claims 1, 18, 30 and 41.

Claim 1. Independent Claim 1 was objected to for reciting the limitation "*said communications*", for which the Examiner stated that there was insufficient antecedent basis in the claim.

In response, the Applicant has replaced the term "*said communications*" with "*communication*".

Claim 18. Claim 18 was objected to for reciting the limitation "*the broadcast information*", "*the artist*", and "*the album*", for which the Examiner stated that there as insufficient antecedent basis in the claim. Since Claim 18 does not contain those phrases, the Applicant surmises it is Claim 19 at issue in this regard.

Accordingly, the Applicant has amended "*the broadcast information*" in Claim 19 to read "*broadcast clips*".

Claims 19, 30 and 41. Dependent Claims 19, 30 and 41 were objected to because the Examiner stated that the phrases "*the artist*", "*the album*", and "*the purchase*" lacked antecedent basis.

In response, the Applicant has amended those claims by changing the definite article "the" to "a" or "an" as appropriate.

2. Rejection of Claims 21-24, 31-32, 34-37 and 41 under 35 U.S.C. § 112.

Claims 21-24, 31-32, 34-37, and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, the Applicant has amended the claims as follows:

Claims 21-22. These claims have been amended to recite "*said first wireless connection*".

Claim 23. This claim has been amended to recite "*said ~~established~~ second*".

wireless connection".

Claim 24. This claim has been amended by replacing "*said connection*" with the phrase "*said first wireless connection*". In addition, the acronym (WAP) for wireless application protocol has been included to simplify understanding. Also the term "*includes*" has been replaced with the term "*comprises*".

Claim 31. This claim has been amended to clarify the comparison of the separate communication connection as having a longer range than the Bluetooth protocol connection.

Claim 32. The rejection indicates that Claim 31 recites the limitation "*said first and second wireless connection*". However, that phrase is not found in Claim 31 but in Claim 32. The amendment to Claim 31 above corrects the antecedent basis in Claim 32.

Claims 34-37 and 41. Section 7 of the Office Action indicates that these claims are also subject to a 35 USC 112 rejection. However, no details were provided. Claims 34-37 appear to have proper antecedent basis. In Claim 41, "*the artist*" has been changed to "*an artist*".

3. Rejection of Claims 1-27, 30-32, 34-37 and 41-43 under 35 U.S.C. § 103(a).

Claims 1-27, 30-32, 34-37 and 41-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lehtonen (U.S. Pat. Appl. Pub. 2001/0049262) in view of Bowman et al. (U.S. Pat. Appl. Pub. 2002/0174431).

As a preliminary remark concerning this particular rejection, the Applicant points out that the present rejections are based on the same references as in the previous Office Action, and the Applicant's prior response was found persuasive. The teachings of the cited references remain unchanged through prosecution, and the Applicant respectfully submits that the cited combination still does not read on the recited claims when interpreted according to the requirements of the MPEP.

Claim 1. Independent Claim 1 was rejected based on combining Lehtonen and Bowman. However, a number of shortcomings arise in this rejection as the elements of

these references do not correspond to elements recited in Applicant claims.

The rejection asserts characteristics for the Lehtonen reference which are not borne out by the reference itself, including the following.

#### **Reference Elements Do NOT Comport with Claim Elements**

A number of intractable shortcomings with the rejection stem from problems with the elements of the reference being equated to elements of Applicant's claim although they do not equate with those claim elements. Specifically, in this rejection the teachings of Lehtonen are improperly characterized toward supporting an assertion that these aspects comport with those recited in the claims, and specifically Claim 1 in this case.

Before proceeding into details, Applicant points out that the rejection completely fails with regard to equating the storage of music files within the headset of Lehtonen as being the same as "*data marking*" in response to "*bookmarking of a broadcast clip*" as recited in the claims. A number of clear distinctions are wholly ignored in characterizing the claim elements taught within the instant application. Data marking clearly is not a process of recording music. It will also be noted that music can be recorded from the radio without any interaction with a server. In addition, data for music recording is being received by the headset of Lehtonen, and not being sent from the first device for receipt by the second device. Furthermore, the "data marks" taken by the data marking device cannot be played on the data marking device. The marks only provide a means by which content elements may be identified by an external means, in particular the server device of the instant application, after the marks have been passed through the connection made with the second wireless device. Still further, in a recording process there is no retrieval of information corresponding to said marked data. In overview we thus see shortcomings arising at the very core of the rejection. We turn now to the specific details of the rejection.

(a) Lehtonen is considered to be a "*data marker integrated device communication system*" as recited in the preamble of Claim 1. Specifically stated as "*Regarding claim*

1, Lehtonen discloses a data marker integrated device communication system (Fig. 3)".

The rejection mischaracterizes Lehtonen in relation to how these aspects are taught in Applicant's specification.

In mischaracterizing the teachings of Lehtonen into a "data marker integrated device communication system", the rejection fails to consider the meaning of this phrase as clearly taught by the relevant portions of Applicant's specification. Applicant strongly contends that upon even a casual reading of Applicant's specification, the phrase "data marker integrated device communication system" would by no means be equated to the hands-free headset of Lehtonen (Refer to MPEP 2111) by one of ordinary skill in the art.

The distinction with regard to data marks and bookmarking are brought out repeatedly in the Applicant's specification, such as on page 1, lines 23-31:

*Sony Corporation and its U.S. subsidiary, Sony Electronics, Inc., introduced an electronic music marker device which is capable of "bookmarking" a music clip while being played on a radio and is capable of recalling the information related to the bookmarked music clip such as the name of the song, the artist, the album containing the song and so on. Using the electronic music marker device, a user can conveniently access the music clip information that the user listened to on the radio at a later time without the need to memorize the information or wait hopefully for the disc jockey on the radio to provide that information.* (emphasis added)

The first line of the claim even explicitly describes what a "data marker integrated device" is configured to perform, and that is "a data marker integrated device configured to store a data mark in response to bookmarking of a broadcast clip". Which is clearly dissuasive of holding that Lehtonen is a "data marker integrated device communication system", based on the ability of the Lehtonen headset to retain songs or even to record music. Not surprisingly, this aspect of the language of Claim 1 is not considered in putting forth Lehtonen as a "data marker integrated device communications system".

Also strongly arguing against Lehtonen as a "data marker integrated device communication system" is the combination with Bowman itself. In supporting the need of this combination, Examiner has stated "However, Lehtonen does not disclose storing

*a data mark in response to bookmarking of a broadcast clip*", which is in fact close to encapsulating what the term "*data marker integrated device communication system*" is directed to in Applicant's specification. So Lehtonen as a "data marking" device, as necessitated by this being the primary reference, is directly refuted in seeking the support of the Bowman reference. The prior response traversed the combination of Bowman as primary with Lehtonen as secondary reference, and it is clear that flipping the references around, as per this Office Action, does not overcome the basic shortcomings of these references either separately or in combination.

(b) Lehtonen is improperly interpreted as "*a data marker integrated device (Fig. 2, 21; Fig. 3,21) configured to store a data mark (e.g., index of user files stored in a memory card of the device) in response to bookmarking of a clip (e.g., user storing a file, such as a multimedia file, audio/video file, MP3 music file) (section 0008, 0009, 0011-0014, 0016, 0039, 0041);*" as was asserting in the rejection.

Applicant appreciates Examiner's forthrightness with regard to the parenthetical expressions above which explicitly on what basis the attempt is made to redefine the terms "*data mark*" and "*bookmarking*". However, it is not permissible to redefine elements of the claim as the terms therein must be interpreted with regard to the specification of the instant application.

The difference between storing a "*data mark in response to bookmarking of a broadcast clip*" and the storing of MP3 files, as in Lehtonen, are wholly distinct. Examiner interprets the "*data mark*" recited in the claim as equivalent to an "*index*" as described by Lehtonen in relation to the storage of files thereupon, as seen by the following paragraph.

Lehtonen paragraph [0039]:

"FIG. 5b illustrates a WML page showing the contents of a memory card inserted in the headset as an index. The index comprises information on the files/pieces of music stored in the memory card. In addition to the name of the file/piece of music 'SONG

NAME 1, SONG NAME 2, SONG NAME 3, ...", said information may include for example the size of the file/piece of music. In the case of FIG. 5b, the size of the piece of music SONG NAME 1 is 2.14 megabytes, that of SONG NAME 2 4.51 megabytes and that of SONG NAME 3 3.38 megabytes."

However, the term "*index*" is a common database term relating to a first hierarchical - level relational primitive, and has no relevance to the "*data mark in response to bookmarking of a broadcast clip*". Lehtonen provides an ability as in a conventional MP3 player to store songs and to list those songs contained in its memory with information such as name, size and/or duration; which are aspects of a conventional file or media storage system. Lehtonen is not even communicating these indexes, such as through multiple wireless means, to a remote server for retrieving playlist data. In fact, Lehtonen clearly teaches away from retrieving playlist information as the indexes it retains point to music already contained within the player of Lehtonen, such as in the memory card of Fig. 5b. Accordingly, one of ordinary skill in the art will readily recognize that Lehtonen CAN NOT be construed as a data marker device as recited by Applicant claims. Wherein Lehtonen cannot be used as a primary reference against Claim 1, or the other claims of the instant application.

(c) Elements of Lehtonen are improperly construed as being related to aspects of the "*data marker integrated device*" in Claim 1. First, nothing is described with regard to "(Fig. 2, 21; Fig. 3, 21)" which comports to any use of data marking, and in particular a "*data mark in response to bookmarking of a broadcast clip*". Element 21 in both of these figures is referred to by Lehtonen as "*headset 21*", which in paragraph [0026] is described as "*The headset 21 comprises two stereo earpieces 23 (right and left), each of which comprises a speaker 24 for stereo playback of music. The headset 21 also comprises a microphone 25, a headband 26 and an electronics module 27.*" Nothing has been put forth, and Applicant is unable to find anything, of the Lehtonen headset which would possibly be construed by one of ordinary skill in the art as being "*a data marker integrated device configured to store a data mark in response to bookmarking of a broadcast clip*".

The rejection also misconstrues the bookmarking process as “*bookmarking of a clip (e.g., user storing a file, such as a multimedia file, audio/video file, MP3 music file) (section 0008, 0009, 0011-0014, 0016, 0039, 0041);*”. However, as has been discussed above, there is no basis on which to consider the bookmarking of content, for storing a data mark in response to bookmarking of a broadcast clip, as being identical to storing of one of these music files by Lehtonen, or indexes of the files.

(d) Additional problems are found in the body of the rejection, in that Lehtonen does not communicate “data marks” at all, and certainly does not communicate data marks through wireless devices.

(e) In addition, the aspects of the server element in Claim 1 are grossly mischaracterized within the rejection. Paragraphs [0035]-[0039] and [0041] within Lehtonen are said to support “*retrieving playlist data in response to receipt of said data mark from said first device*”. However, the referenced sections do not deal with either the use of data marks stored in response to bookmarking of a broadcast clip, or to the retrieval of playlists. The relied-upon sections of Lehtonen only disclose that wireless communication takes place, and as per paragraph [0041] of Lehtonen, that music can be communicated to the device. Furthermore, Lehtonen does not describe a similar server configuration, nor is anything described within regard to user accounts on the server.

(f) Finally, the combination with Bowman is put forth specifically toward trying to cover the lack of data marking by Lehtonen. This assertion is contradictory to the statements put forth in support of Lehtonen as the primary reference against Claim 1. This section of the rejection states: “*However, Lehtonen does not disclose storing a data mark in response to bookmarking of a broadcast clip and said server is configured for: retrieving playlist data in response to receipt of said data mark from said first device and communicating over a data network with a user terminal so that said user terminal can access said playlist data through a user account on said server when connected over said data network.*”

(g) The previous response has already dealt with the issues surrounding the Bowman reference. Claim 1 of the instant Application recites a first device (data marking device) configured for local, short range, communication and a second device configured for establishing a separate second wireless connection. In the rejection, the first device is considered to comprise DPS device 112, while the second wireless device is also considered to comprise DPS 112, as shown in Fig. 1 of Bowman. Thus, according to this rejection the wireless communication is considered to arise between device 112 and itself, which is contradictory to logic and the plain meaning of the terms within Claim 1.

According to Bowman, mobile device 110 or stationary DPS 112 (alternative devices), are configured to communicate directly with the vendor managed DPS 122 as described in paragraph [0024] of Bowman: *"The user then transmits the bookmark from mobile device 110 to vendor managed DPS 122 by pressing another button on device 110."* Device 110/112 are mobile devices configured to directly communicate with remote facilities, and thus cannot be considered to be limited to "local, short range, communication" as recited in Claim 1.

From the specification and claims of the instant application it is clear that the network device 102 of the instant application, which is also shown in FIG. 3, does not comport to a simple interface as represented by the network interface 114 of Bowman. The instant application describes network device 102 comprising different user devices, such as *"WAP-enabled mobile telephone, i-mode telephones, internet access enabled personal digital assistants (PDAs), and the like"*, and not as a part of the network infrastructure as it is used by Bowman.

Bowman discusses device 110 communicating directly with database 122 (paragraph 0024), and only mentions *"network interface 114"* in paragraph [0021] as being *"coupled to a communications network 118 (the Internet or PSTN) via a communications channel 116..."*. There is no user interaction described for network interface 114 of Bowman wherein this must be considered in the traditional sense as an



NIC, or similar. It should be understood that as NICs are generally inherent within a given network infrastructure, they are not described within the instant application.

Thus the elements of Claim 1 do not comport, as asserted, to elements taught by the Lehtonen reference, while the combination with Bowman is improper and does not correct the missing elements.

#### **Combination Asserted on the Basis of Hindsight**

The lack of teachings, suggestion or motivation present within either of the references indicates another problem with the rejection, as brought out in MPEP 2143.01.

**"THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)."**

However, it has been shown that neither references is directed at solving the problem to which the instant application is directed and whose solution is found recited in the claims of the instant Application. Lehtonen providing a hands-free phone and Bowman of collecting broadcast station identification as an adjunct to a data mark. Neither of these references address the data marking from a first wireless device in communication with a second wireless device which communicates the data mark and collects information from a server device.

### **Invention Not Considered as a WHOLE**

The re-interpretation of clear teachings of the specification and claims are indicative of a more far-ranging problem with the rejection, that is the invention has not been properly considered as a whole, but instead as a collection of parts open to being reinterpreted and distilled down arbitrarily. The MPEP provides guidelines directly averse to such holdings.

MPEP 2142.02: DISTILLING THE INVENTION DOWN TO A "GIST" OR "THRUST" OF AN INVENTION DISREGARDS "AS A WHOLE" REQUIREMENT  
Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole". *Jones v. Hardy*, 727 F.2d 1524 220 USPQ 1021, 1026 (Fed. Cir. 1984) ("treating the advantage as the invention disregards statutory requirement that the invention be viewed 'as a whole' ").

### **Different Objects and Operating Principles**

The teachings of Lehtonen and Bowman are not directed at similar objects and operating principles to one another. Further problematic is that neither of these references is directed to similar objects or operating principles of the invention recited in Applicant's Claim 1.

Lehtonen is entitled "HANDS-FREE FUNCTION" as it is directed to a hands-free phone function utilizing a hands-free headset and telephone, while music stored on the phone can be played when calls are not in progress. As mentioned previously, there is no description for this device having a data marking capability, in which a data mark is stored in response to bookmarking of a broadcast clip. Bowman is directed at a simple retrieval of music information in response to station information, as well as time and date. Bowman is not directed at the use of intermediary wireless devices which provide interfacing and functionality with respect to the data marks. Clearly Lehtonen and Bowman are thus directed at different objects and operating principles.

Another mitigating factor against the rejection is that the claim at issue (Claim 1) of Applicant's invention solves a different problem than either of these cited references,

and such a solution is clearly recited in the Applicant's claims. Refer to *Wright*, 6 USPQ 2d 1959 (1988). The claimed invention is directed to the problem of getting data marks from a local (first device) data marker, through a second device to a server which the specification defines as being adapted for retrieving information about the data marks which can be accessed by a user.

This is clearly not the object of the Bowman reference as it is directed to capturing data marks on a device configured for long range communication and directly communicating these marks to a remote database. The Lehtonen reference is directed at hands-free telephonic operation and does not relate to a time stamp process for broadcast events. Neither of these references (Bowman or Lehtonen) have an object which comports to that brought out in Applicant claims.

MPEP 2143.01A describes that the objects and operating principles provide an implicit showing of whether a *prima facie* case of obviousness can be established. Yet the references are each singularly distinct from the objects and operating principles of the instant application.

Also problematic is that in asserting a combination between Lehtonen and Bowman the question arises; how could a motivation or suggestion for combination arise from references that neither cite, nor have need of, nor would benefit from the combination? Neither Lehtonen nor Bowman are directed at solving the data marking problem of the instant application, wherein it logically follows that neither can provide ANY motivation toward making said combination. There exists no suggestion, teaching or motivation which can be found in either reference from which a person having ordinary skill in the art would find it obvious to modify the teachings of Lehtonen to correspond to that described in Applicant claims, and specifically Claim 1, which recites structure patentable over the cited references for purposes of 35 U.S.C. § 103.

Further evidence that the rejection lacks proper foundation is found in the statement put forth in support of the combination with Bowman within this office action, specifically: "*One of ordinary skill in the art would have been lead to make such as*

*modification to provide the ability to bookmark or store a radio program from a FM radio receiver of the headset or first device, wherein a user listening to a radio program and selects to store a segment of the broadcast in the memory card of the headset and provide a server that can store the data mark...*. This statement improperly describes "data marking" as being equivalent to recording (storing) a portion of the broadcast; thus illustrating an endemic problem underlying the rejection as a whole.

Therefore, in response to the above shortcomings, Claim 1 is clearly non-obvious in relation to the references taken separately or in combination, while the combination and whose combination still does not result in the claimed invention. Applicant respectfully requests that the rejection of Claim 1, and the claims that depend therefrom, be withdrawn.

Claim 20. Independent Claim 20 is drawn to a method which describes data marker integrated device communication system.

The rejection of Claim 20 is given in similar manner to that of Claim 1, and suffers from similarly intractable shortcomings.

(a) At the very heart of the problems with this rejection is that Lehtonen is improperly considered to be a "data marking device" which performs "bookmarking of a broadcast clip". Simply stated, this assertion has no validity as has been brought out with regard to Claim 1 above, as Lehtonen provides NO TEACHING WHATSOEVER of "data marking" as that term is known in the claim and taught in the specification of the instant application.

The rejection attempts to equate the storage of music files within the headset of Lehtonen as being the same as "data marking" in response to "bookmarking of a broadcast clip". In positing the rejection, a number of clear distinctions are being wholly ignored or misconstrued regarding the claim elements taught within the instant application. Data marking as represented in the instant Application and claims is clearly not a process of recording music. It will also be noted that music can be recorded from the radio without necessitating any interaction with a server. In addition, data for music

recording would be received by the headset, and not being sent from the first device for receipt by the second device as given in Claim 20. Furthermore, the “*data marks*” taken by the data marking device cannot be played on the data marking device. The marks are NOT CONTENT, and provide a means by which content elements may be identified by an external means, in particular the server device, after the marks have been passed through the connection made with the second wireless device. Still further, in a recording process there is no retrieval of information corresponding to said marked data.

Even seen broadly, Claim 20 addresses the storage of a data mark in response to bookmarking of a broadcast clip which is directed through the second wireless device to a user account within a server, wherein information is retrieved from the server in response to the marked data, said information being made available on a user terminal. This is clearly not the process of recording broadcast music, or downloading music, which each involve a data stream received at the headset of Lehtonen. Consequently, even the broadest view illustrates the intractable nature of the shortcomings.

(b) In view of the mischaracterization of Claim 20 elements, as outlined above, it is also clear that the claimed invention is not being properly considered as a whole, but instead the claim is being interpreted apart from Applicant's specification and arbitrarily distilled down toward making comparison with the cited references. MPEP 2142.02 indicates that “*distilling an invention to a ‘gist’ or ‘thrust’ disregards the requirement of analyzing the subject matter ‘as a whole’.*”

(c) The asserted combination with Bowman brings up a number of additional problems. In particular, there is no guidance on specific hardware modification, as taught in one of the references, for combining the Bowman reference into the Lehtonen reference to yield Applicant's invention. When such a lack of specificity exists in the suggestions to modify a reference then the Examiner has failed to make out a *prima facie* showing of obviousness. Upon examining the references it is seen that neither an explicit nor an implied suggestion of Applicants' elements are found therein, with regard

to the structure for handling the data marks. Examiner has articulated no clear statement as to the source of the suggestion to modify the Lehtonen reference to yield or make obvious the elements of Applicants' combination. (See MPEP § 706.02(j)).

It is well founded that specific evidence for making a proposed combination is required. For example, referring to the outcome of appeal No. 2000-1201 for Application No. 08/817,825 (Page 6 - 7).

"The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. *See, e.g., C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232. **Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."**" *Id.* at 999, 50 USPQ2d at 1617 (citing *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993); *In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)). (*emphasis added*)

(d) In combining Lehtonen with Bowman the question naturally arises; how is there a motivation or suggestion if these references have no need, or would not benefit from the combination? It should be noted that since neither Lehtonen nor Bowman are directed at solving the data marking problem of the instant application, neither can thus provide ANY motivation toward making said combination. Since, thus by definition, there is no suggestion, teaching or motivation which can be found in either reference from which a person having ordinary skill in the art would find it obvious to modify the teachings of Lehtonen to correspond to that described in Applicant claims, and specifically Claim 1, which recites structure patentable over the cited references for purposes of 35 U.S.C. § 103.

(e) The nature of these shortcomings appear to indicate that fundamentally the rejection is borne of hindsight based on Applicant's own teachings. This contention is sustained by the following observations: (1) that the language of Lehtonen, which cannot be considered a data marking device, is mischaracterized in an attempt to read on claim elements, while a plain reading of those terms in relation to Applicant's

specification illustrate no correspondence between Lehtonen and the instant application; (2) that a reference (Lehtonen) which is not directed to any data marking objects whatsoever is put forth as a primary basis of rejection; (3) that as neither reference provides any suggestion or motivation toward the objects of the instant application the only place where such would arise is from Applicant's own teachings.

Any one of the above shortcomings illustrate the impropriety of the rejection based on the combination with Lehtonen.

Therefore, Claim 20 is non-obvious in relation to the cited references, which neither separately or in combination, result in the invention, nor provide any teaching, suggestion, incentive or motivation to combine these references. Applicant respectfully requests that the rejection of Claim 20, and the claims that depend therefrom, be withdrawn.

Claim 31. Independent Claim 31 is drawn to a method which describes data marking though the first and second devices. The rejection of Claim 31 is given in similar manner to that of Claims 1 and 20, and suffers from similar shortcomings.

(a) In positing the combination with the primary reference of Lehtonen, the Lehtonen device is considered to describe *"storing a data mark within a data marking device, as a first device"*; however there is no support for this conjecture. The device of Lehtonen is a hands-free headset and telephone, wherein music stored on the phone can be played when calls are not in progress. None of the referenced portions of Lehtonen provide any description of a data marking capability, as that term is clearly understood according to the instant invention. Lehtonen describes the storage and recording of music when the headset is not being utilized for a phone call, and thus lacks any relevance to data marking.

The rejection is thus founded on a reference whose objects and operating principles are diverse and distinct from those of the instant application. In putting forth the rejection, the elements of the claim are improperly misconstrued as has been brought out in detail with regard to Claim 1 and Claim 21 above. The storage and/or recording

of music cannot be equated to data marking. Clear evidence of this is provided by the allowance of the preceding data marking patents, which had data marking been equivalent to music storage and recording, these patents would not have been issued. Lehtonen is improperly considered to be a "*data marking device*" which performs "*bookmarking of a broadcast clip*", despite the fact that Lehtonen provides NO TEACHING WHATSOEVER of "*data marking*" as that term is known in the claim and taught in the specification of the instant application.

The rejection attempts to equate the storage of music files within the headset of Lehtonen as being the same as "*data marking*" in response to "*bookmarking of a broadcast clip*". In positing this rejection a number of clear distinctions are ignored or mischaracterized regarding the claim elements taught within the instant application. Data marking as represented in the instant Application and claims is clearly not a process of recording music. It will also be noted that music can be recorded from the radio without necessitating any interaction with a server. In addition, data for music recording would be received by the headset, and not be sent from the first device for receipt by the second device as given in Claim 31. Furthermore, the "*data marks*" taken by the data marking device cannot be played on the data marking device. The marks are NOT MEDIA CONTENT, as they serve to provide a means by which content elements may be identified by an external means, in particular the server device, after the marks have been passed through the connection made with the second wireless device. Still further, in a recording process there is no retrieval of information corresponding to said marked data.

Claim 31, even viewed broadly, addresses the storage of a data mark in response to bookmarking of a broadcast clip which is transmitted from first wireless device to a second wireless device and then wirelessly conveyed to a user account within a server, wherein information is retrieved from the server in response to the marked data, said information being made available on a user terminal. This is clearly not the process of recording broadcast music, or downloading music, which each



involve a data stream received at the headset of Lehtonen. Consequently, even the broadest view illustrates the intractable nature of the shortcomings.

(b) The improper reinterpretation of the elements Claim 31 and that of the Lehtonen reference are clearly indicative that the instant application is not being considered as a whole, but instead is being interpreted piece-meal, apart from Applicant's specification, by distilling down elements for the object of making positive comparison with the cited references. MPEP 2142.02 indicates that "*distilling an invention to a 'gist' or 'thrust' disregards the requirement of analyzing the subject matter 'as a whole'.*"

(c) Asserting the combination to modify the Lehtonen reference, brings up a number of additional problems. In particular, there is no guidance on specific hardware modification to be performed to yield Applicant's invention. When such a lack of specificity exists in the suggestions to modify a reference then the Examiner has failed to make out a *prima facie* showing of obviousness. Upon examining the references it is seen that neither an explicit nor an implied suggestion of Applicants' elements are found therein, with regard to the structure for handling the data marks. Examiner has articulated no clear statement as to the source of the suggestion to modify the Lehtonen reference to yield or make obvious the elements of Applicants' combination. (See MPEP § 706.02(j)). It is well founded that specific evidence for making a proposed combination is required.

(d) In putting forth the modification of Lehtonen the question naturally arises; how is there a motivation or suggestion if these references have no need, or would not benefit from the combination? It should be noted that since neither Lehtonen nor Bowman are directed at solving the data marking problem of the instant application, neither can thus provide ANY motivation toward making said combination. Since, thus by definition, there is no suggestion, teaching or motivation which can be found in either reference from which a person having ordinary skill in the art would find it obvious to modify the teachings of Lehtonen to correspond to that described in Applicant claims,

and specifically Claim 1, which recites structure patentable over the cited references for purposes of 35 U.S.C. § 103.

(e) The nature of these shortcomings appear to indicate that fundamentally the rejection is borne of hindsight based on Applicant's own teachings. This contention is sustained by the following observations: (1) that the language of Lehtonen, which cannot be considered a data marking device, is misconstrued in an attempt to read on claim elements, while a plain reading of those terms in relation to Applicant's specification illustrate no correspondence between Lehtonen and the instant application; (2) that a reference (Lehtonen) which is not directed to any data marking objects whatsoever is put forth as a primary basis of rejection; (3) that as neither reference provides any suggestion or motivation toward the objects of the instant application the only place where such would arise is from Applicant's own teachings.

As with the preceding independent claims, any one of the above shortcomings illustrate the impropriety of the rejection based on the combination with Lehtonen.

Therefore, Claim 31 is non-obvious in relation to the cited references, which neither separately or in combination, result in the invention, nor provide any teaching, suggestion, incentive or motivation to combine these references. Applicant respectfully requests that the rejection of Claim 31, and the claims that depend therefrom, be withdrawn.

Claims 42-43. Independent Claims 42-43 are drawn to a data marker integrated device communication system utilizing data marking which is communicated from data marking device, a first device, and through a second device to a server. The rejection of Claims 42-43 are given in similar manner to that of Claims 1, 20 and 31, and suffers from similar shortcomings.

(a) In positing the combination with the primary reference of Lehtonen, the Lehtonen device is considered to describe "*means for storing a data mark within a data marking device, as a first device*"; however, there is no support for this conjecture. The device of Lehtonen is a hands-free headset and telephone, wherein music stored on the

phone can be played when calls are not in progress. None of the referenced portions of Lehtonen provide any descriptive material about data marking capability, as that term is clearly understood according to the instant invention. Lehtonen describes the storage and recording of music when the headset is not being utilized for a phone call, and thus lacks any relevance to data marking.

The rejection is thus founded on a reference with different objects and operating principles from those of the instant application. In putting forth the rejection, the elements of the claim are improperly misconstrued as has been brought out in detail with regard to Claim 1, 21 and 31 above. The storage and/or recording of music cannot be equated to data marking, as evidenced by the allowance of preceding data marking patents over long-known music storage and recording systems. Lehtonen is improperly considered to be a "*data marking device*" which performs "*bookmarking of a broadcast clip*", despite the fact that Lehtonen provides NO TEACHING of "*data marking*" as that term is known in the claim and taught in the specification of the instant application.

The rejections attempt to equate the storage of music files within the headset of Lehtonen as being the same as "*data marking*" in response to "*bookmarking of a broadcast clip*". In positing this rejection, a number of clear distinctions are ignored or mischaracterized regarding the claim elements taught within the instant application. Data marking as represented in the instant Application and claims is clearly not a process of recording music. It will also be noted that music can be recorded from the radio without necessitating any interaction with a server. In addition, data for music recording would be received by the headset, and not be sent from the first device for receipt by the second device as given in Claims 42-43. Furthermore, the "*data marks*" taken by the data marking device cannot be played on the data marking device. The marks are NOT MEDIA CONTENT, as they serve to provide a means by which content elements may be identified by an external means, in particular the server device, after the marks have been passed through the connection made with the second wireless device. Still further, in a recording process there is no retrieval of information

corresponding to said marked data.

Claims 42-43 address the storage of a data mark in response to bookmarking of a broadcast clip which is transmitted from first wireless device to a second wireless device and then wirelessly conveyed to a user account within a server, wherein information is retrieved from the server in response to the marked data, said information being made available on a user terminal. This is clearly not the process of recording broadcast music, or downloading music, which each involve a data stream received at the headset of Lehtonen. Consequently, even the broadest view illustrates the intractable nature of the shortcomings.

(b) The improper reinterpretation of the elements Claims 42-43 and that of the Lehtonen reference are clearly indicative that the instant application is not being considered as a whole, but instead is being interpreted piece-meal, apart from Applicant's specification, by distilling down elements for the object of making positive comparison with the cited references. MPEP 2142.02 indicates that "*distilling an invention to a 'gist' or 'thrust' disregards the requirement of analyzing the subject matter 'as a whole'.*"

(c) Asserting the combination to modify the Lehtonen reference, brings up a number of additional problems. In particular, there is no guidance on specific hardware modification to be performed to yield Applicant's invention. When such a lack of specificity exists in the suggestions to modify a reference then the Examiner has failed to make out a *prima facie* showing of obviousness. Upon examining the references it is seen that neither an explicit nor an implied suggestion of Applicants' elements are found therein, with regard to the structure for handling the data marks. Examiner has articulated no clear statement as to the source of the suggestion to modify the Lehtonen reference to yield or make obvious the elements of Applicants' combination. (See MPEP § 706.02(j)). It is well founded that specific evidence for making a proposed combination is required.

(d) In putting forth the modification of Lehtonen the question naturally arises;

how is there a motivation or suggestion if these references have no need, or would not benefit from the combination? It should be noted that since neither Lehtonen nor Bowman are directed at solving the data marking problem of the instant application, neither can thus provide ANY motivation toward making said combination. Since, thus by definition, there is no suggestion, teaching or motivation which can be found in either reference from which a person having ordinary skill in the art would find it obvious to modify the teachings of Lehtonen to correspond to that described in Applicant claims, and specifically Claim 1, which recites structure patentable over the cited references for purposes of 35 U.S.C. § 103.

(e) The nature of these shortcomings appear to indicate that fundamentally the rejection is borne of hindsight based on Applicant's own teachings. This contention is sustained by the following observations: (1) that the language of Lehtonen, which cannot be considered a data marking device, is misconstrued in an attempt to read on claim elements, while a plain reading of those terms in relation to Applicant's specification illustrate no correspondence between Lehtonen and the instant application; (2) that a reference (Lehtonen) which is not directed to any data marking objects whatsoever is put forth as a primary basis of rejection; (3) that as neither reference provides any suggestion or motivation toward the objects of the instant application the only place where such would arise is from Applicant's own teachings.

As with the preceding independent claims, any one of the above shortcomings illustrate the impropriety of the rejection based on the combination with Lehtonen.

Therefore, Claims 42-43 are non-obvious in relation to the cited references, which neither separately or in combination, result in the invention, nor provide any teaching, suggestion, incentive or motivation to combine these references. Applicant respectfully requests that the rejection of Claims 42-43, and the claims that depend therefrom, be withdrawn.

3. Traversal of Rejection of Claims 42-43; In re Donaldson.

The Applicant respectfully traverses the grounds for rejection, and cites *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994)(en banc) as the basis for the traversal. Claims 42-43 are written in means plus function form pursuant to 35 U.S.C. §112, sixth paragraph, and therefore, must be interpreted during examination under *In re Donaldson*.

In rejecting Claims 42-43, the Examiner made no specific fact findings as to the scope of equivalents for the means plus function elements in the claims. Instead, the Examiner appears to have followed the provisions of MPEP § 2183 ("Making a Prima Facie Case of Equivalence"), which states:

"If the examiner finds that a prior art element performs the function specified in the claim, and is not excluded by any explicit definition provided in the specification for an equivalent, the examiner should infer from that finding that the prior art element is an equivalent, and should then conclude that the claimed limitation is anticipated by the prior art element. The burden then shifts to applicant to show that the element shown in the prior art is not an equivalent of the structure ... disclosed in the application. *In re Mulder*, 716 F.2d 1542, 219 U.S.P.Q. 189 (Fed. Cir. 1983). No further analysis of equivalents is required of the examiner until applicant disagrees with the examiner's conclusion, and provides reasons why the prior art element should not be considered an equivalent."

While the Examiner appears to have followed the provisions of MPEP §2183, such provisions are contrary to Federal Circuit law. The Federal Circuit has held that an examiner "construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure ... described therein, and equivalents thereof," *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994)(en banc), and in so ruling expressly denied that "the PTO is exempt from this mandate." *Id.* The Federal Circuit added that it was specifically overruling any precedent that suggested or held to the contrary. *Id.* at 1193-94. In response to the PTO's argument that the court's ruling conflicted with the principle that a claim should be given its broadest reasonable interpretation during prosecution, the Federal Circuit

held that the *Donaldson* decision was setting "a limit on how broadly the PTO may construe means-plus-function language under the rubric of 'reasonable interpretation.'" *Id.* at 1194. In other words, an examiner's claim interpretation is not "reasonable" if it is not based on the specification's description of the implementation of the means element of the claim. The court then said, "Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such [means-plus-function] language when rendering a patentability determination." *Id.* at 1195.

Here, as in *Donaldson*, the Examiner is required by statute to look to the Applicant's specification and construe the "means" language as referring to corresponding means disclosed in the specification and equivalents thereof." See *id.* at 1195. However, the Examiner did not construe the means language of these claims, however. Nor did the Examiner find, on the basis of specific facts of record here, that the means disclosed in the Applicant's specification were equivalent to that of the cited references. Instead, as prescribed by MPEP §§ 2183-84, the Examiner simply presumed equivalence. The presumption methodology used here, which the MPEP prescribes, clearly conflicts with the requirements of the Federal Circuit's *Donaldson* decision. The approach taken by the Examiner in this case also conflicts with *In re Bond*, 931 F.2d 831 (Fed. Cir. 1990).

The very point of these cases is that, in this context, limitations from the specification control the interpretation of the claim. Under §112, paragraph 6, a means-plus-function element of a claim must be construed to mean that which is disclosed in the specification and its equivalents. In *Donaldson*, the Federal Circuit said that "our holding does not conflict with the general claim construction principle that limitations found only in the specification of a patent or patent application should not be imported or read into a claim." In other words, the court was saying that a §112, paragraph 6 "means" element does not need to be "imported or read into" a means-plus-function claim because the specification's limitations and their equivalents are already in the claim by virtue of §112, paragraph 6's command. Thus, the Federal

Circuit said (16 F.3d at 1195): "What we are dealing with in this case is the construction of a limitation already in the claim in the form of a means-plus-function clause and a statutory mandate on how that clause must be construed."

Based on the foregoing, the Applicant respectfully submits that the rejection of Claims 42-43, as well as the claims that depend therefrom lacks proper foundation and that the rejection should be withdrawn. Those claims, each of which include means plus function limitations, should have been interpreted in view of the specification as required by *In re Donaldson*. If those claims had been so interpreted, they would have been allowable since the cited references do not, singly or in combination, teach, suggest or provide motivation or incentive for the subject matter recited in those claims.

4. Amendment of Claims 1, 19, 21-24, 30-31 and 41.

Claim 1. The claim has been amended to replace "*said communications*" with "*communication*", to address an issue regarding antecedent basis.

Claim 19, 30 and 41. The phrases "*the artist*", "*the album*" and "*the purchase*", have been amended to read "*an artist*", "*an album*" and "*a purchase*".

Claim 21-22. The phrase "*said wireless connection*" has been amended to recite "*said first wireless connection*" to address an issue regarding antecedent basis.

Claim 23. The phrase "*said established connection*" has been amended to read "*said second wireless connection*" to address an issue regarding antecedent basis.

Claim 24. The phrase "*said connection*" has been amended to read "*said first wireless connection*" to address an issue regarding antecedent basis. In addition, the acronym "(WAP)" for wireless application protocol has been included to increase readability, while the term "*includes*" has been amended to read "*comprises*".

Claim 31. The phrase "*and a separate longer range communication connection*" has been amended to read "*and a separate ~~longer-range~~ second communication connection having a longer range that said Bluetooth protocol connection*".

No new material has been added to the claims, and claim scope remains unchanged.



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5. Amendments Made Without Prejudice or Estoppel.

Notwithstanding the amendments made and accompanying traversing remarks provided above, the amendments have been made with respect to form and are thus made without any prejudice, waiver, or estoppel, and without forfeiture or dedication to the public, with respect to the original subject matter of the claims as originally filed or in their form immediately preceding these amendments.

6. Conclusion.

Based on the foregoing discussion, Applicant respectfully requests that the various grounds for rejection in the Office Action be reconsidered and withdrawn with respect to the discussion presented herein, and that a Notice of Allowance be issued for the present application to pass to issuance.

In the event any further matters remain at issue with respect to the present application, Applicants respectfully request that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matter prior to the next action on the merits of this application.

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Respectfully submitted,



John P. O'Banion, Reg. No. 33,201  
Rodger H. Rast, Reg. No. 45,853  
O'BANION & RITCHEY LLP  
400 Capitol Mall, Suite 1550  
Sacramento, CA 95814  
(916) 498-1010